

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

Amendments to the Drawings:

The attached sheets include changes to Figures 1, 3, 4, 5 and 6A
as discussed in the remarks of this amendment

Attachment: Annotated Sheet showing changes

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

REMARKS

Reconsideration and allowance of the above-referenced application are respectfully requested.

Non Prior Art Rejections

Applicant has made many changes as requested by the Official Action; however all of these are believed to be formal in nature, and should be accepted after final. Many of the changes suggested by the Examiner are believed to be of a character that would raise new issues, and hence are not made herein. These changes which are made should be entered, since they place the case in better condition for appeal.

A number of drawing changes are made herein. Applicant apologizes for the previous confusion in not making all of the proper drawing changes. It is believed that this current set of drawing changes should obviate all of the remaining drawing issues in the case.

The specification stands objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. Applicants respectfully traverses many of these rejections, and has obviated those of the rejections that are not traversed.

Initially, however, note that claims 14, 15, 16 and 20 WERE ORIGINAL CLAIMS, originally filed with this application. The

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

indication that they are not supported by the originally-filed specification is without merit on any ground. The exact language of these original claims has been added to the specification, to obviate any possible issue of lack of antecedent basis.

The first objection is to claim 14, which states that the "quick bid overcomes only those bids which are known". Note that claim 14 is an original claim, and it is hence logically inconsistent to contend that the specification does not support this claim. In any case, since this was an original claim, the subject matter of this claim has been added to page 19 of the specification.

The objection to claim 15 is respectfully traversed for similar reasons: claim 15 is an original claim, and cannot logically be unsupported by the specification. In any case, the specification describes extensively that some bids are, in effect, secret and not known. See for example page 10 lines 10-17.

The objection to claim 16 is similarly traversed. The determining both secret bids and non-secret bids is clearly shown page 20 lines 8-10. In any case, the subject matter of original claim 16 has been added to page 20, since this was an original claim.

Similarly, the subject matter of claim 17 has been added to page 20, since claim 17 was an original claim.

The objection to claim 20 has been added to this section.

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

Whether these sections are allowed or not, these claims are ORIGINAL claims, and cannot logically be considered as new matter or in any way unsupported.

This obviates the objections to the specification on pages 5 and 6, since these were original claims, and as such, clearly cannot be new matter.

The typographical error in the changes to figure 5 has been corrected herein.

Claims 2, 13, 18, 22 and 26 stand objected to based on informalities. Many of these contentions are respectfully traversed.

The suggestions to claim 2 have been adopted.

Claim 13 is believed completely clear as currently written. The claim already says that the operations occur "on a first computer connected to the internet". It is believed that the changes suggested by the official action would raise new issues, preventing an appeal at this point. However, the Examiner is thanked for this suggestion.

Claim 18 defines a programmED computer. With all due respect, if the Examiner's suggestions are adopted, then the claim would no longer define a programmED computer, but would only define a computer which was able to be programmed.

The objections to claim 22 have also been obviated herein by amendment.

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

Claim 25 has also been amended as suggested by the objections, as has claim 26.

The objection to claim 29 is respectfully traversed. The bid is certainly placed using a single click according to the language of figure 7A and 7B. Admittedly, there is a confirmation of whether we want the bid to be actually placed, but the bid itself is placed with a single click. See figure 7A which shows quick bid, shows that a single "click", is made on the quick bid. A single click on that quick bid places the bid. While admittedly thereafter there may be a confirmation, the bid itself is placed with a single click.

With all due respect, the rejection reads this claim as though the claim read "the entire bid is placed with a single click and that no other clicks are necessary to confirm.". Claim 29 does not recite this -- it only says that the bid is "placed". Figure 7A clearly shows one click on the quick bid to place the bid.

Claims 2, 5, 13-17, 21, 22, 25, 26 and 29 stand rejected as allegedly failing to comply with the adequate written description requirement. These contentions are factually incorrect, and are respectfully traversed.

For claim 2, the objection queries how the amount required to overcome any current bids is used to determine whether an entered bid is higher than the current bid without the user viewing the amount required. As explained on page 16, the local

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

"applet" runs on the user's terminal. This is updated with minimum bid amounts, and winning bid amounts. The agent is therefore able to accept or reject the bid substantially immediately. See page 16 lines 9-10. Figure 6A (page 16 line 17-18) may be executed when maximums are known to all agent applets. However, if the new bid is greater than the winning bid at 640, see the bottom of page 17, other bids which are going to be released at later times may be investigated by the agent manager. The winning bid may not be known to all agents, see the bottom of page 17. The test at 650 determines if the current bid is greater than the minimum., and therefore this determines whether the entered bid is higher than a current bid amount, and does so without contacting the first computer.

Applicant does not wish to get involved in the hypothetical posed on page 9 of the office action, which has nothing to do with the words of the claim. The words of the claim only have to do with whether there are secret bids that can be overcome.

The "current winning amount" in claim 13 does not mean that it will win the auction; it only means that it is higher than any known bid. There may be a higher bid somewhere out there, that is maintained secret. Just like on eBay today: just because you are the winner an hour before the end of the auction does not mean that there are not people out there willing to place bids that allows to from your winning position.

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

With all due respect, the objection to claim 25 simply states that the bid is allowed to be placed without contacting the first computer. Claim 25 does not recite that the bid is actually placed with the first computer without contacting the first computer.

Claims 2, 5, 22 and 25 stand rejected under 35 USC 112, second paragraph, as allegedly being indefinite.

Regarding claim 2, applicant agrees that allowing placing bids is not the same as placing bids. However, this allowing bids to be placed (in a method claim) certainly does further limit the claim, since it states that the bids are allowed to be placed. This clause also states that there is a second computer connected to the Internet.

Regarding claim 5, the indefiniteness rejection is respectfully traversed, and it is unclear what relevance to the "user" has to a claim that states providing the bids to an agent program which keeps the bid secret until a time of day and day specified by the indication. It is not understood what relevance this has to "whether the user really knows the current bid and further how can you keep an entered bid secret by the user". Claim 5 says nothing about the user: it only says providing the bids to an agent.

Applicants respectfully traverse the objection that a second computer must be recited in claim 13. Claim 13 defines hosting the auction, and the ability to bid.

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

The objection to "enabling the quick bid" is also respectfully traversed, the ability to allow something to happen is certainly a limitation, whether it actually is recited as happening or not.

With regards to claim 16, applicants respectfully traverse the objection for similar reasons to those discussed above. With regard to claim 22, applicants respectfully traverse the objection for similar reasons to those discussed above. With regard claim 25, the "current maximum bid" is believed completely clear in context. Hence, this contention is respectfully traversed.

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

Rejections Based on Prior Art

Claims 2, 5, 25, 26 and 28 stand rejected under 35 USC 102b as allegedly being unpatentable over Ebay's proxy bidding, herein "Ebay". This contention is respectfully traversed.

The undersigned reiterates the point that all claim limitations must be considered.

Consider, by analogy, the law on printed matter, such as set forth in In re Miller, 164 USPQ 46 (CCPA, 1969). In that case, the CCPA required that the examination take into account the claimed printed matter, even though printed matter by itself was unpatentable. Similarly here - the Patent office must consider, all claim limitations. The patent office is not entitled to ignore any claim limitation, whether it is the method steps or the information in the database. Information in the database that is recited in the claim must be given patentable weight. Miller, by analogy, seems squarely on point.

In rejecting claim 2, the rejection's interpretation of what eBay does, does not properly consider the limitations of the claim. Information is stored on the second computer about an amount that will be required to overcome any current bids on the item. EBay does not currently store that kind of information on the local computers. EBay may store information about what the next bid increment will be, but that information does not store

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

on the second computer, anything about the amount that will be required to overcome any current bids on the item as claimed.

An agent program is certainly used by eBay, but the rejection completely ignores claim 5's limitation of time of day and date. This is completely incorrect.

The rejection to claim 22 is similarly respectfully traversed. eBay does not currently store secret information on the local computers.

Similarly, the rejection to claim 25 is incorrect. eBay does not currently store secret information on the local "second" computer. The scenario outlined at the bottom of page 13 is entirely beside the point. eBay does not currently store secret information on the local computer. A computer connected to eBay has no way of determining whether an entered bid is higher than the secret maximum bid. Therefore, claim 25 is patentable.

Therefore, the Graham v John Deere "scope and contents" does not show the subject matter of these claims, and hence the patent office has not met their burden of coming forward with a prima facie showing of unpatentability.

Claims 13-17 and 21 stand rejected based on eBay in view of Hartmann. This contention remains respectfully traversed. The limitations of the eBay reference have been extensively discussed above. Nowhere does eBay teach or suggest a quick bid. Moreover, and with all due respect, Hartmann teaches a system of a quick item purchase, which teaches nothing about a quick

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

auction win. While quick purchase may sound like a quick auction win, it is very different. Claims 13 recites features which are specific to an auction, and which would not be used in a one click order scenario. In a one click order scenario there is an established exact price. The single click of Hartmann puts together that established price with user information and processes the order. A one click auction, on the other hand, requires actually determining the price using ending the auction. Hartmann teaches nothing about how to do that part. Nothing in eBay teaches how to establish that price and keep secret that price.

A one click end to an auction is quite simply antithetical to any established conventional teaching in the art. A typical auction attempts to find the highest possible price for the item. A one click end to an auction goes against that established wisdom.

Therefore, a person having ordinary skill in the art would not be motivated to combine Hartmann with eBay. Even if one wanted to make that combination, one would obtain no guidance on how to do so.

Even if the combination were made, one would only obtain an eBay style bidding system with a Hartmann style "one click purchase" of an item with a fixed price. Nothing in the combination of prior art shows a one click purchase of an item in a bidding style scenario.

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

Therefore, claim 13 should be allowable along with the claims which depend therefrom.

Claim 17 should be even further allowable, as it defines an extra fee beyond that which would be charged for only nonsecret items. The statement that the claim does not recite any method steps is contrary to the law which requires that the patent office consider all elements of the claim. Here, the patent office has simply ignored the claimed elements.

Claims 18-20 and 29 similarly stand rejected based on eBay in view of Hartmann. This is even further respectfully traversed. Nothing in Hartmann teaches or suggests how a bid could be sent to a server with one click. Nothing in eBay teaches or suggest this either. The rejection is entirely based on hindsight, at nowhere is there any teaching or suggestion of sending a bid with a single click. Therefore, the combined "scope and contents" does not disclose the claimed features.

It is believed that all of the pending claims have been addressed in this paper. However, failure to address a specific rejection, issue or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

For all of these reasons, it is respectfully suggested that all of the claims should be in condition for allowance. A formal notice of allowance is hence respectfully requested.

If the Examiner believes that communications such as a telephone interview or email would facilitate disposal of this case, the undersigned respectfully encourages the Examiner to contact the undersigned.

Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail (using the email address scott@harrises.com). I understand that a copy of these communications will be made of record in the application file.

Please charge any fees due in connection with this response, (including the one month extension of time paid via EFS), to Deposit Account No. 50-1387, small entity.

Respectfully submitted,

Date: 8/28/07

 /Scott C Harris/
Scott C. Harris
Reg. No. 32,030

Appl. No. : **09/669,805**
Filed : **September 26, 2000**

Customer No. 23844
Scott C. Harris, Esq.
P.O. Box 927649
San Diego, CA 92192
Telephone: (619) 823-7778
Facsimile: (858) 678-5082

REPLACEMENT SHEET
ANNOTATED

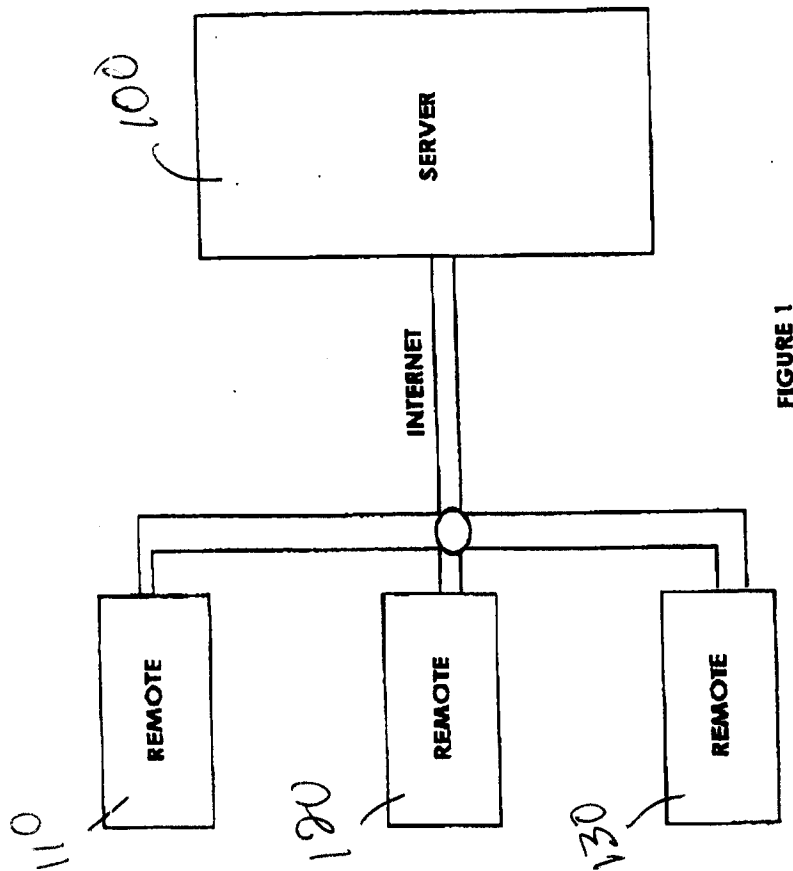


FIGURE 1

REPLACEMENT SHEET
ANNOTATED

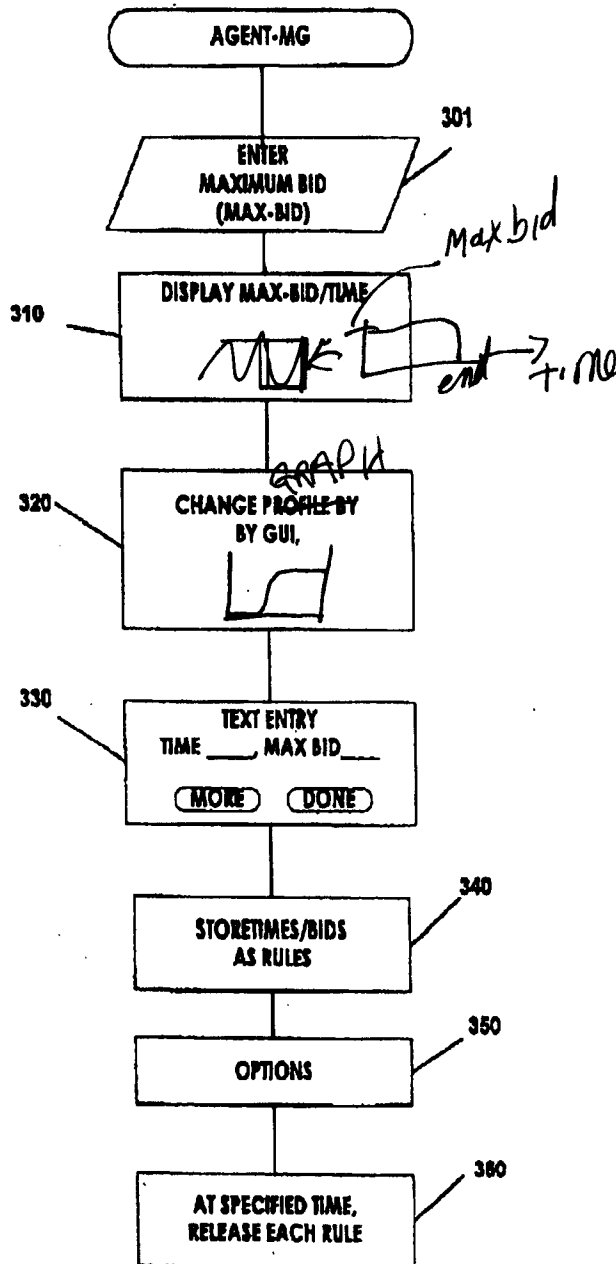


FIGURE 3

REPLACEMENT SHEET ANNOTATED

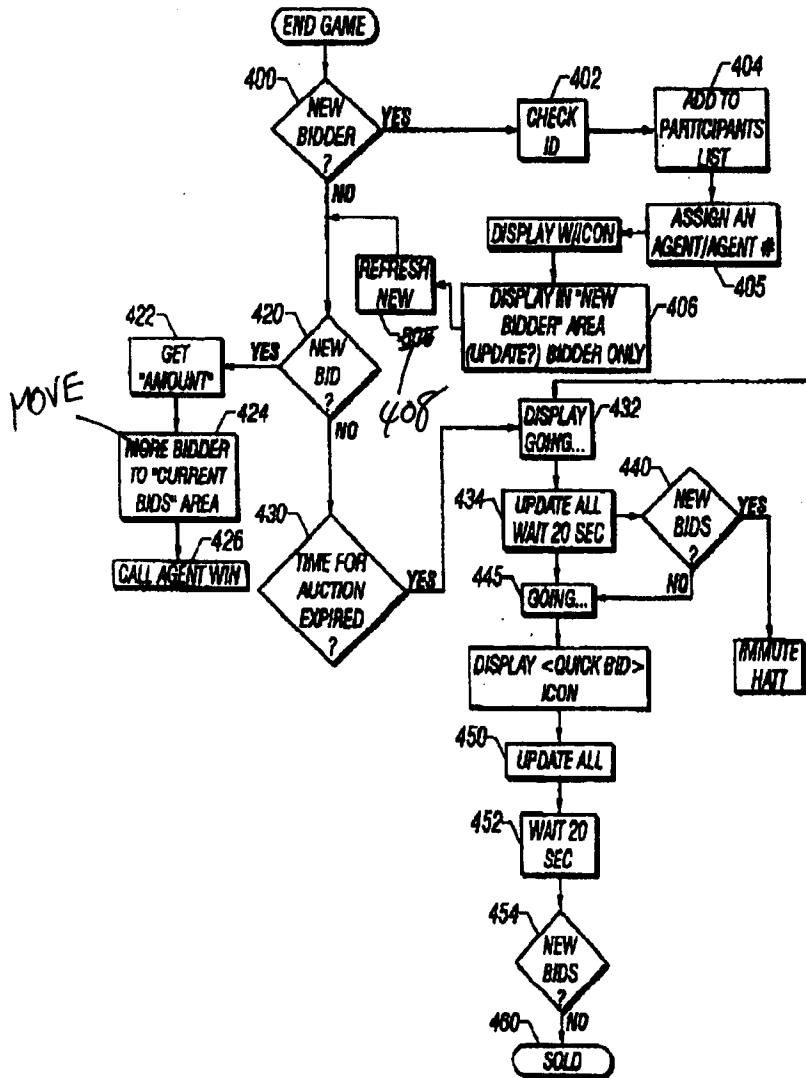


FIG. 4

ANNOTATED

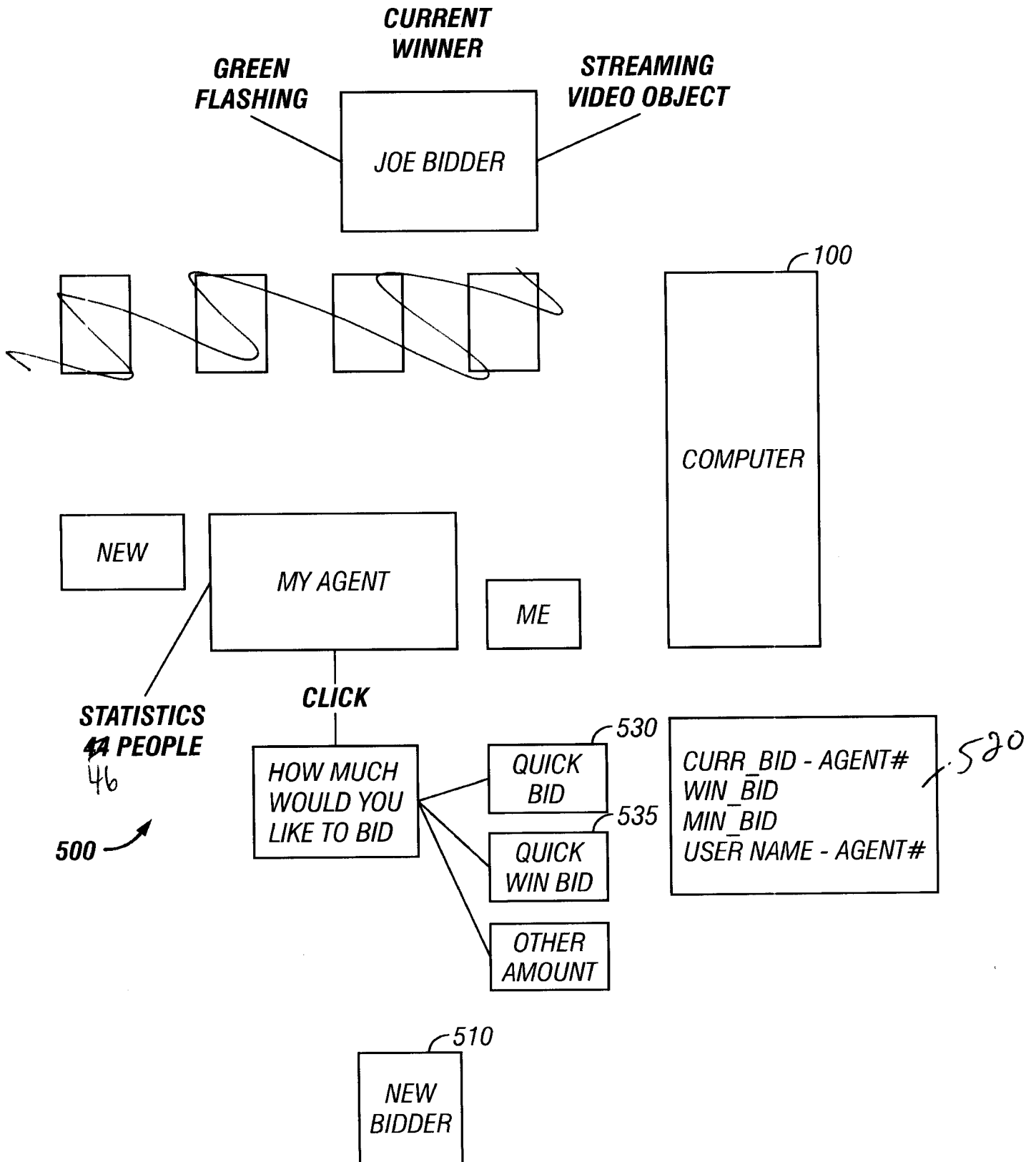


FIG. 5

REPLACEMENT SHEET ANNOTATED

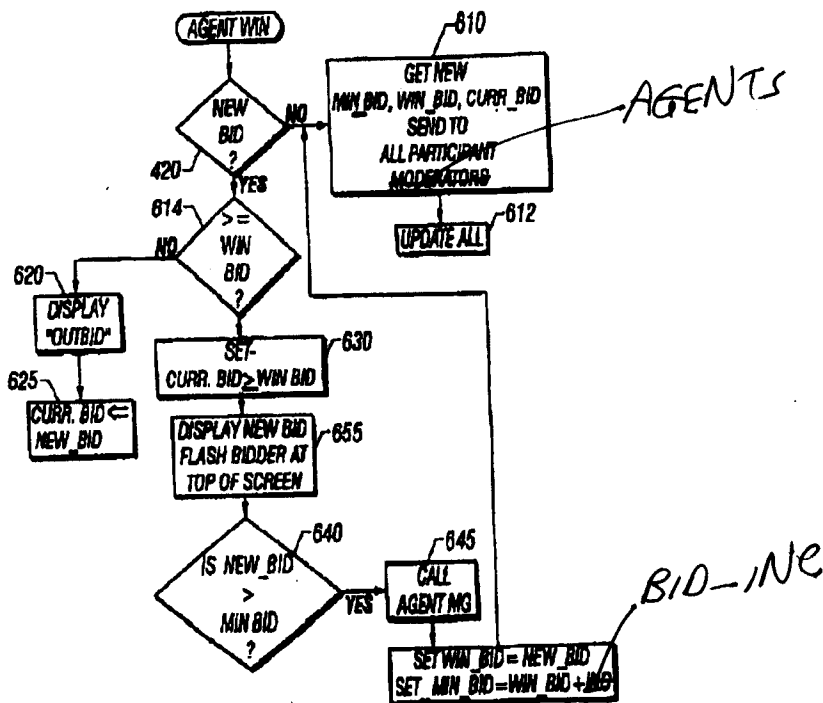


FIG. 8A

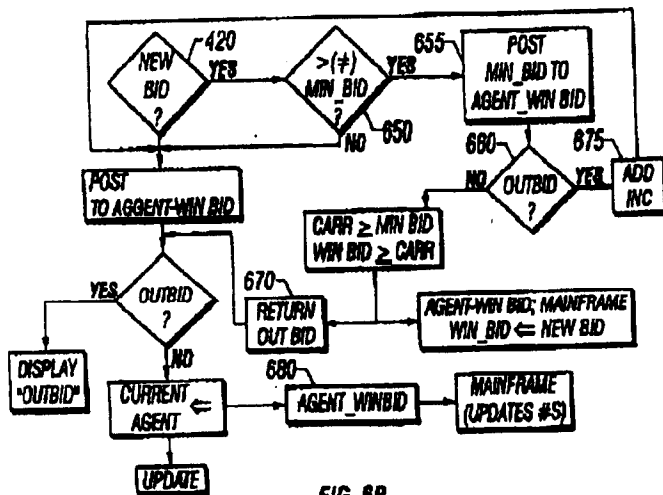


FIG. 8B

conclusion of law and requires no discussion.⁴

The decision of the board is *affirmed*.

Court of Customs and Patent Appeals

In re MILLER

No. 8212 Decided Dec. 18, 1969

PATENTS

1. Patentability — Subject matter for patent monopoly — Printed matter (§51.611)

Fact that printed matter by itself is not patentable subject matter, because nonstatutory, is no reason for ignoring it when claim is directed to combination.

Particular patents—Measuring Device

Miller, Measuring Device, claims 10 to 13 of application allowed.

Appeal from Board of Appeals of the Patent Office.

Application for patent of Paul J. Miller, Serial No. 332,183, filed Dec. 20, 1963; Patent Office Group 285. From decision rejecting claims 10 to 13, applicant appeals. Reversed.

THOMSON & SCHOVEE (JOHN R. SCHOVEE of counsel) both of Rochester, N. Y., for appellant.

JOSEPH SCHIMMEL (FRED W. SHERLING of counsel) for Commissioner of Patents.

Before RICH, Acting Chief Judge, MATTHEWS, Judge, sitting by designation, and ALMOND, BALDWIN, and LANE, Associate Judges.

RICH, Acting Chief Judge.

⁴ Appellee's brief has called our attention to two other oppositions brought by appellant against a third party, dismissed by the board, and at the argument appellant called attention to another one in which its opposition was sustained. None of these cases has a direct bearing on the present case but we refer to them as of interest. The present board decision antedates these decisions. *Witco Chemical Co. v. The Chemische Werke Witten G. M. B. H.*, Opp. No. 42,425, 157 USPQ 644; Opp. No. 42,421, 157 USPQ 647; Opp. No. 43,003, 158 USPQ 157.

This appeal is from the decision of the Patent Office Board of Appeals affirming the rejection of claims 10-13 of application serial No. 332,183, filed December 20, 1963, entitled "Measuring Device." Claims 9 and 14 were allowed in the Examiner's Answer.

The disclosed invention has for its purpose the solving of the domestic culinary problem of measuring the ingredients from a cookbook recipe in something other than the full recipe. While it contemplates measuring out multiple recipes, for example a double recipe, it particularly contemplates solving the greater difficulty of measuring out fractional recipes, such as $1/3$ or $1/2$. Normally this would involve the calculation of such baffling measurements as $1/3$ or $2/3$ of a cup, which, it is assumed, would tax the mathematical abilities of many housewives. From the utility point of view, we will assume this to be so in the absence of any assertion by the Patent Office to the contrary. Indeed, we think we can judicially notice the fact.

While the rejection cites no references to establish prior art, we nevertheless have to take prior art into consideration because it is assumed on both sides that common kitchen measuring cups and spoons are well known. This is recognized by the specification which states:

The required measurements of ingredients of most recipes are in terms of the common fractions of cups, tablespoons, etc., appearing on commercially available measuring cups and spoons.

The problem faced by the housewife or other cook is stated in the specification as follows:

However, when a housewife wants to make a fractional recipe, few of the computed fractional measurements appear as graduations on commercially available measuring devices. Hence, even if the housewife is able to make the fractional or proportional computations or has a conversion chart, many of the computed measurements are only fractions of the graduations on the housewife's measuring devices. For example, even though a housewife is able to compute that $1/3$ of $2/3$ cup is $2/9$ cup, and $1/2$ of $3/4$ is $3/8$ cup, she will not find such fractional cup graduations on her measuring cup.

We do not doubt that this presents a practical problem for many housewives, and for many cooks who are not housewives.

Appellant has provided equipment—

s appeal is from the decision of the Office Board of Appeals affirming rejection of claims 10-13 of application No. 332,183, filed December 9, 1963, entitled "Measuring Device." Claims 9 and 14 were allowed in the Examiner's Answer.

The disclosed invention has for its purpose the solving of the domestic culinary problem of measuring the ingredients from a cook book recipe in something other than a measuring device. While it contemplates measuring out multiple recipes, for example a single recipe, it particularly contemplates the greater difficulty of measuring fractional recipes, such as $1/3$ or $1/2$. Usually this would involve the calculation of such baffling measurements as $1/3$ of a cup, which, it is assumed, taxes the mathematical abilities of the housewives. From the utility point of view, we will assume this to be so in the event of any assertion by the Patent Office to the contrary. Indeed, we think the Patent Office should notice the fact.

While the rejection cites no references to establish prior art, we nevertheless have taken prior art into consideration because it is assumed on both sides that common kitchen measuring cups and spoons are well known. This is recognized by the specification which states:

The required measurements of ingredients of most recipes are in terms of the common fractions of cups, tablespoons, and teaspoons appearing on commercially available measuring cups and spoons.

The problem faced by the housewife or cook is stated in the specification as follows:

However, when a housewife wants to use a fractional recipe, few of the common fractional measurements appear as graduations on commercially available measuring devices. Hence, even if the housewife is able to make the fractional proportional computations or has a conversion chart, many of the computed measurements are only fractions of the graduations on the housewife's measuring devices. For example, even though a housewife is able to compute that $1/3$ of a cup is $2/9$ cup, and $1/2$ of $3/4$ is $3/8$, she will not find such fractional cup graduations on her measuring cup.

It is not doubt that this presents a practical problem for many housewives, and for cooks who are not housewives. The applicant has provided equipment—

articles of manufacture, under the statute, 35 U.S.C. 101—adapted to ameliorate the mental strain on cooks. The invention takes different forms. In the language of the claims there is, broadly, a measuring receptacle; more particularly, there is a spoon or a cup-shaped receptacle. The first element of each claim is the *receptacle*.

The second element of each claim is, as stated in the specification:

*** quantity measuring *indicia* on the receptacle of a selected ratio or proportion to, but different from the actual quantity measured in the receptacle by the *indicia*. [Emphasis ours.]

To explain, the *indicia* on a cup or spoon may indicate, for example, that it is measuring one cup or one tablespoon but the actual volumetric content of the receptacle, reading the *indicia*, in whatever form they may take, against its contents, is something different, say $1/3$ cup or $1/3$ tablespoon. In

other words, the *indicia*, if taken literally and by themselves, are false.

The third element in each appealed claim is a *legend*, on the receptacle or attached to it, specifying the ratio or proportion of a full recipe which the above-mentioned false *indicia* actually measure in the receptacle. We do not use the term "false" in any derogatory sense; actually the false designation, coupled with the legend, serves as a computing or mathematical conversion device. A cook following a cook-book recipe and desirous of making $1/3$ of the recipe merely selects measuring devices bearing the " $1/3$ recipe" legend, follows the recipe using these devices, and measures out what it calls for by following the *indicia* on the measuring receptacles. They perform the calculations automatically and require no further thought.

Figs. 2 and 3 from the drawings are illustrative:

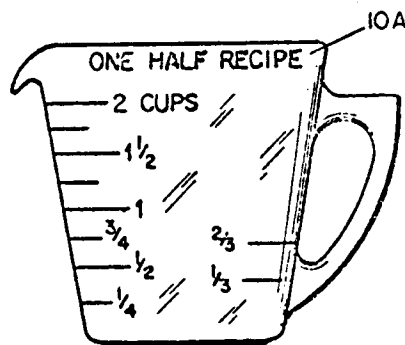


FIG. 2

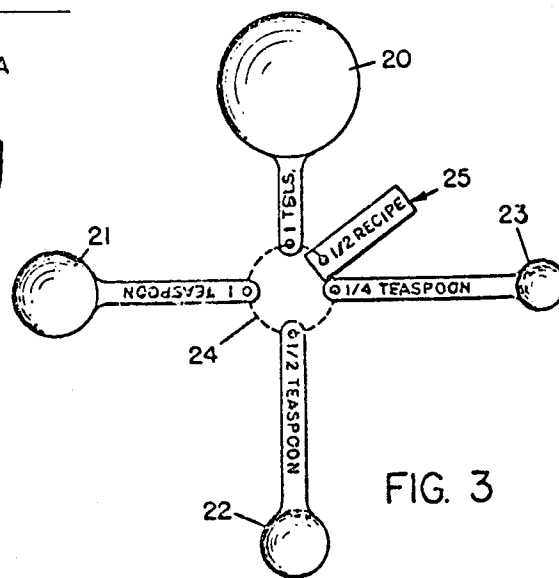


FIG. 3

Fig. 2 shows a measuring cup having the legend "ONE HALF RECIPE." The *indicia* on the side wall reading upward from $1/4$ cup to 2 cups indicate the points at which the cup's volume is actually $1/2$ of what the *indicia* state, i.e., filled to "2 CUPS" the actual volume is one cup. Similarly in Fig. 3, the familiar set of measuring spoons has been altered in accordance with the invention so that, for example, the spoon 21 to the left bearing the *indicia* "1 TEASPOON" on its handle

actually measures, in accordance with the legend 25, a half teaspoon.

Claim 10 is illustrative of the rejected claims (emphasis ours):

10. A measuring device comprising: a spoon for measuring ingredients; and volume measuring *indicia* defined in a normal volumetric unit on said spoon of a selected ratio to but indicating a volume different from the actual volume of ingredients being added to and measured in said spoon

by said indicia, and a *legend* attached to said spoon specifying said ratio.

In his Answer, the examiner stated that no references were relied on. (Up to that point, it appears that his rejections had been based entirely on prior-art patents.) The rejection by the examiner which the board affirmed, and which is before us for review, was as follows:

Claims 10-13, which recite the combination of a measuring vessel having printed thereon (1) *indicia* specifying a given volume and (2) a *legend* specifying the ratio of this given volume to the actual volume that the vessel is capable of holding, are rejected as defining over any ordinary measuring vessel only by the addition of unpatentable printed matter. In this instance the claimed indicia and legend, being merely placed on the claimed structure in any desired location and manner, do not produce the required cooperative structural relationship necessary before the printed matter can be given patentable weight. It is believed to be well settled that patentable weight can be given printed matter only when a novel relationship exists between said printed matter and the claimed structure.

No authorities were cited by the examiner in his Answer, to support what he said was well-settled law or otherwise. We consider the examiner's rejection unsound logically, if not self-defeating, and we reverse.

It is noted, first, that the examiner recognizes the invention of the appealed claims for what it is, namely, a combination of three elements constituting a "manufacture" 35 U.S.C. 101. There is no assertion that the *claimed* invention is non-statutory subject matter.

It is noted, next, that the rejection appears to be based either on 35 U.S.C. 103 or 112 by reason of the statement that it "[defines] over any ordinary measuring vessel only" in a certain respect. The statutory basis is not specified. Thus an "ordinary measuring vessel" is assumed prior art, notwithstanding no references are relied on. The respect in which the appealed claims admittedly *do* "define over" such prior art is in their recitations of the "*indicia*" and the "*legend*," two of the three elements of each rejected claim, as clearly recognized by the examiner. While the examiner was quite willing to consider such elements as proper parts of the "structure" and in "a definite structural relationship with the

wall of the measuring vessel" when, as in the allowed claims, they were required to be in "a specific location," he would give them no weight at all, apparently, when the location was not specified or necessarily restricted. He said, and we repeat (our emphasis):

In this instance the claimed indicia and legend, being *merely placed on* the claimed structure [meaning the vessel] in *any desired location and manner*, do not produce the required co-operative *structural* relationship necessary before the printed matter can be given patentable weight.

We do not see why this is so and the examiner does not tell us.¹ We do not see that "structural" relationship—whatever that means—is required to obtain the practical, problem-solving results of appellant's invention. In fact, it is apparent that such restrictions as the examiner insists on would deprive the Fig. 3 embodiment of the invention of protection. Further, as the solicitor pointed out at the argument, if all of the indicia of the Fig. 2 cup except the "ONE HALF RECIPE" legend and the "2 CUPS" indicia were removed from Fig. 2, one would then have the subject matter of the appealed claims; yet, that subject matter would not be protected by the allowed claims.

It seems to us that what is significant here is not structural but *functional* relationship and that it is of no moment with respect to measuring devices such as the spoons, where the volume is measured by *filling the receptacle to its brim*, which could also be true of a cup, in what position on or relation to the receptacle the indicia and legend are placed. Claims 10-12 call for the indicia being "on" and the legend being "attached to" the receptacle. Claim 13 specifies that the indicia and the legend are both "on" the "cup-shaped receptacle." This specifies the required functional relationship to carry out appellant's invention and clearly defines the disclosed invention as required by section 112.

[1] As for the examiner's characterization of the indicia and legend as "unpatentable printed matter," we note that the examiner himself recognizes the fact that

¹ The examiner did not care, apparently, where the *legend* was for in allowed claims 9 and 14 the legends were merely recited as "on said receptacle." But he did think the volumetric *indicia*, such as the "2 CUPS" scale on Fig. 2, *supra*, should have a *specific* relation to the receptacle other than merely being "on" it.

measuring vessel" when, as in claims, they were required specific location," he would weight at all, apparently, tion was not specified or icted. He said, and we re- isis):

nce the claimed indicia and merely placed on the claimed aning the vessel] in any de- and manner, do not produce co-operative structural rela- essary before the printed given patentable weight.

why this is so and the ex- ort tell us.¹ We do not see al" relationship—whatever required to obtain the prac- olving results of appellant's fact, it is apparent that s as the examiner insists ive the Fig. 3 embodiment i of protection. Further, as inted out at the argument, cia of the Fig. 2 cup except HALF RECIPE" legend "PS" indicia were removed ne would then have the of the appealed claims; ct matter would not be allowed claims.

us that what is significant ictural but functional rela- it is of no moment with uring devices such as the the volume is measured ceptacle to its brim, which ue of a cup, in what posi- on to the receptacle the in- l are placed. Claims 10-12 a being "on" and the legend o" the receptacle. Claim 13 indicia and the legend are "cup-shaped receptacle." e required functional rela- out appellant's invention ines the disclosed inven- y section 112.

ie examiner's characteriza- a and legend as "unpatent- atter," we note that the f recognizes the fact that

lid not care, apparently, where in allowed claims 9 and 14 merely recited as "on said e did think the volumetric : "2 CUPS" scale on Fig. 2, e a specific relation to the a merely being "on" it.

printed matter, in an article of manufacture claim, can be given "patentable weight." He did so in allowing claims. His characterization of printed matter as "unpatentable" is beside the point; no attempt is here being made to patent printed matter as such. The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination. Here there is a new and unobvious functional relationship between a measuring receptacle, volumetric indicia thereon indicating volume in a certain ratio to actual volume, and a legend indicating the ratio, and in our judgment the appealed claims properly define this relationship. No question as to the novelty or unobviousness of the invention as claimed is before us except with relation to an "ordinary measuring vessel." By implication, the examiner admits that no such combination exists in or would be obvious from an ordinary measuring vessel and we therefore deem sections 102 and 103 to be satisfied.

The solicitor seeks some support for sustaining the rejection in *In re Sterling*, 21 CCPA 1134, 70 F.2d 910, 21 USPQ 519, but we find none therein. As we pointed out in *In re Jones*, 54 CCPA 1218, 373 F.2d 1007, 153 USPQ 77, also cited by the solicitor, the *Sterling* claims were held unpatentable over prior art references. The solicitor seems to urge that we ignore the claim limitations to the indicia and legends because they are printed and because printed matter is not patentable subject matter by itself. For reasons indicated above, we reject that argument.

The decision of the board affirming the rejection of claims 10-13 is reversed.

Patent Office Trademark Trial and Appeal Board

In re MARRIOTT CORPORATION
Decided Oct. 22, 1969

TRADEMARKS

1. Acquisition of marks — Character and extent of use — Advertising (\$67.0733)

Use of mark on menu does not constitute trademark use thereof for sandwiches.

Appeal from Examiner of Trademarks.

Application for registration of trademark of Marriott Corporation, Serial No. 216.-843. From decision refusing registration, applicant appeals. Affirmed.

BROWNE, SCHUYLER & BEVERIDGE, Washington, D. C., for applicant.

Before LEACH, WALDSTREICHER, and SHRYOCK, Members.

LEACH, Member.

An application has been filed to register "TEEN TWIST" for sandwiches.

The specimens filed with the application are menus upon which the term "TEEN TWIST" appears as a designation for a type of sandwich.

The Examiner of Trademarks has refused registration on the ground that the specimens referred to do not evidence use of "TEEN TWIST" as a trademark.

[1] The precise issue raised by this appeal, i.e., whether or not use of a mark on a menu constitutes a trademark use thereof, has heretofore been determined in the negative by this Board in *In re Marriott-Hot Shoppes, Inc.*, reported in 156 USPQ page 257. And the arguments advanced by applicant in the present case are not persuasive that our decision in the prior case involved error.

Decision

The refusal of registration is affirmed.